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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,832	07/10/2003	Yoshifumi Tanimoto	030733	8885
38834	7590	04/09/2008	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP			FRINK, JOHN MOORE	
1250 CONNECTICUT AVENUE, NW				
SUITE 700			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20036			2142	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/615,832	TANIMOTO, YOSHIFUMI	
	Examiner	Art Unit	
	JOHN M. FRINK	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 February 2008.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-6 and 11-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-6 and 11-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

Response to Arguments

Applicant argues that Chang in view of Wakasugi do not address 'not sending a new mail notification when the received e-mail is a reception confirmation mail of an e-mail transmitted previously'. However, as stated above, Chang in view of Wakasugi do disclose this through teaching not sending, though the push method, low priority confirmation messages, where a user can specify what is and is not low priority. The ability to specify not pushing low priority messages, as shown by Chang in view of Wakasugi, is to avoid flooding the user with undesired/low priority mail, said undesired/low priority claimed by Applicant as 'reception confirmation mail of a e-mail transmitted previously.' Applicant's argument is not persuasive. For additional information, please refer to the rejection of claim 1 below.

Applicant next argues, claim language now contained in currently pending claim 11, that "delivering a message without the attached document is completely different from not transmitting the new mail notification if no attachment is present". However, "not transmitting the new mail notification is no attachment is present" is not what is claimed. Rather, Applicant claims not transmitting "the electronic mail of the new mail notification". Chang shows this claim language in col. 4 line 30 - col. 5 line 25, as Chang may be configured to only push notifications (the claimed "new mail notification") not the mail which the notification is informing the user of (the claimed "electronic mail of the new mail notification" (emphasis added)). Applicant's argument thus is not persuasive.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al. (US 6,292,825 B1), hereafter Chang.

3. Regarding claim 11, Chang discloses a mailbox which stored received electronic mail by corresponding each electronic mail and an electronic mail address of a destination (Abstract, Figs. 2, 4 and 5, col. 4 lines 32 – 43);

means for transmitting electronic mail of a new mail notification to the electronic mail address of the destination of a received electronic mail by a push method protocol; and (Abstract, Fig. 2, col. 4 lines 32 – 43)

means for distributing the electronic mail by a pull method protocol in accordance with a distribution request from the electronic mail address of the destination electronic mail stored in the mailbox (Figs. 2, 4 and 5)

wherein the means for transmitting transmits the electronic mail of the new mail notification by the push method protocol when the type of the received electronic mail is an electronic mail of a type designated in advance (col.4 lines 30 – 67)

where the means for transmitting determines not to transmit the electronic mail of the new mail notification by the push method protocol when the received electronic mail is an electronic mail not attached with an attached file (col. 4 line 30 – col. 5 line 2).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 3, 4, 6, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (US 6,292,825 B1), hereafter Chang, in view of Wakasugi et al. (US 6,823,367 B1), hereafter Wakasugi.

3. Regarding claim 1, Chang et al. (US 6,292,825 B1), hereafter Chang, discloses a mailbox which stores received electronic mail by corresponding each of the electronic mail and an electronic mail address of a destination; means for transmitting electronic mail of a new mail notification to the electronic mail address of the destination of a received electronic mail by a push method protocol (Abstract, col. 4 lines 32 - 43, Fig. 2); and

means for distributing the electronic mail by a pull method protocol in accordance with a distribution request from the electronic mail address of the destination of the electronic mail stored in the mailbox (Figs. 2, 4 and 5),

wherein the means for transmitting determines whether or not to transmit the electronic mail of the new notification by the push method protocol in accordance with a type of received electronic mail (col. 4 lines 32 - 43, col. 5 lines 22 - 26, col. 6 lines 44 - 51).

Chang additionally shows allowing users to set a priority for which types of email

notifications should be sent (col. 4 lines 30-65, col. 5 lines 20-27).

Chang does not disclose not transmitting the electronic mail of the new mail notification by the push method protocol when the received electronic mail is a reception confirmation mail of electronic mail transmitted previously.

Wakasugi discloses the receiver of an email sending delivery confirmation messages to the sender of said email (col. 3 lines 30-35, col. 10 lines 4 - 18), thus showing an email's sender knowing when sent message have been received.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang with that of Wakasugi so that the status important messages could be verified though the use of email confirmation messages, and also to avoid inundating a user with undesired email, not verifying the status of low priority messages.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang with that of Wakasugi in order to ensure only important and desired messages are received (Chang, col. 4 lines 32 - 43, col. 5 lines 22 - 26, col. 6 lines 44 -51).

4. Regarding claims 2 and 6, Chang in view of Wakasugi further discloses a mail server and mail receiving terminal devices according to claims 1, 4 and 11, including where the push method protocol is SMTP (Wakasugi, col. 5 lines 30 – 35, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

5. Regarding claim 3, Chang discloses a mail server and mail receiving terminal devices according to claim 1.

Chang does not disclose where the pull method protocol is POP.

Wakasugi discloses POP (col. 5 lines 35 – 38, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang with that of Wakasugi in order to utilize an industry standard mail protocol.

6. Regarding claim 4, Chang in view of Wakasugi disclose where when the electronic mail address of the destination of the received electronic mail is an electronic mail address designated in advance, the means for transmitting transmits electronic mail of a new mail notification by the push method protocol (Chang col. 4 line 30 – col. 5 line 30).

7. Regarding claim 14, Chang discloses a mail server and mail receiving terminal devices according to claim 11.

Chang does not disclose where the push method protocol is SMTP.

Wakasugi discloses utilizing SMTP (col. 5 lines 30 – 35, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang with that of Wakasugi in order to utilize an industry standard mail protocol.

8. Regarding claim 15, Chang in view of Wakasugi disclose the means for transmitting notifies an amount of data of the received electronic mail by electronic mail of a new mail notification (Chang, col. 4 lines 60 - 67).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Wakasugi, as applied to claim 1 above, further in view of Boyle et al. (6,119,167), hereafter Boyle.

10. Regarding claim 5, Chang in view of Wakasugi show claim 1.

Chang in view of Wakasugi do not show means for registering whether or not to carry out the new mail notification to each of a plurality of electronic mail addresses; wherein the means for transmitting determines whether or not to carry out a new mail notification in accordance with registered contents of the means for registering.

Boyle shows means for registering whether or not to carry out the new mail notification to each of a plurality of electronic mail addresses; wherein the means for transmitting determines whether or not to carry out a new mail notification in accordance with registered contents of the means for registering (col. 11 line 59 – col. 12 line 10).

It would have been obvious to one of ordinary skill in the art to modify the disclosure of Chang in view of Wakasugi with that of Boyle in order to support additional email push and pull options and configurations, making the resulting invention more customizable to user's needs.

11. Claims 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Chang, further in view of Beyda et al. (US 6,275,850 B1), hereafter Beyda.

12. Regarding claim 12, Chang discloses the mail server according to claim 11.

Chang does not disclose where pushing the attachment when the received electronic mail is an electronic mail which a file of a prescribed type is attached as an attached file.

Beyda discloses where pushing the attachment when the received electronic mail is an electronic mail which a file of a prescribed type is attached as an attached file (Fig. 3, col. 3 lines 1 – 14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang with that of Beyda in order to allow the user to more accurately specify which emails they would like pushed to them in order to save the user the time spent downloading the attachments and well as the cost of the bandwidth utilized to download said attachments.

13. Regarding claim 13, Chang in view of Beyda further disclose claim 12.

Chang in view of Beyda do not disclose where the prescribed type is an image file or a file in a format converted into character data from the image.

The examiner takes official notice that image files were notoriously old and well known at the time of the invention.

It would have been obvious to one of ordinary skill in the art to process/consider files where the prescribed type is an image file or a file in a format converted into character data from the image as said file types are commonly emailed as attachments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Frink whose telephone number is (571) 272-9686. The examiner can normally be reached on M-F 7:30AM - 5:00PM EST; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Andrew Caldwell/
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